

REMARKS

Claims 1, 8, and 15 have been amended. Accordingly, claims 1, 4 – 8, 11 – 24 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, claims 17 and 21 – 24 continue to be allowed; claims 1, 4 - 8, 11 – 14, 16, and 18 -20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5, 150,458 to Masuzaki et al. in view of U.S. Patent No. 5,732,230 to Cullen et al.; and claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Masuzaki et al. in view of Cullen et al. and in view of U.S. Patent No. 5,959,867 to Speciner et al.

By this Response and Amendment, claims 1, 8, and 15 have been amended for clarity. The rejections under 35 U.S.C. §103 are traversed.

Therefore, it is respectfully submitted that the above amendments do not introduce any new matter to this application within the meaning of 35 U.S.C. §132. It is also submitted that the above amendments presents the rejected claims in better form for consideration on appeal.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 4 -8, 11 – 14, 16, and 18 -20 as being unpatentable over Masuzaki et al. in view of Cullen et al.; and claim 15 was rejected as being unpatentable over Masuzaki et al. in view of Cullen et al. and in view of Speciner et al.

Response

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success;

and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Applicant respectfully traverses the Examiner's rejections since all of the features of the presently claimed invention are not disclosed, taught or suggested in the cited prior art.

Claim 1 recites, *inter alia*, "wherein...a display section displaying collectively as a group a plurality of image information of each of the plurality of desired original monochromatic images..., and wherein the display section enables display of a plurality of groups prior to combining said plurality of desired original monochromatic images." [emphasis added]

Claim 8 recites, *inter alia*, "wherein the control section outputs collectively as a group a plurality of image information of the plurality of desired original monochromatic images selected by the control section to a display section..., wherein the control section allows the display section to display a plurality of groups prior to combining said plurality of desired original monochromatic images. [emphasis added]

Masuzaki et al. discloses an electronic image information filing apparatus displaying editing corrections. The Examiner admits that Masuzaki et al. fails to teach or suggest all of the features of independent claims 1 and 8 and cites Cullen et al. in an attempt to cure the deficiencies of Masuzaki et al.

Cullen et al. teaches a computer user interface for manipulating image fragments using drag, drop and merge operations. In FIG. 5, six rectangular page fragments are arbitrarily arranged as two rows and three columns of pages. In FIG. 6, the user has manipulated the page fragments so that the pages are aligned with each other to recreate the original oversize image. Note that, in FIG. 6, the

pages are shown overlapping each other in order to obtain the integrated image. FIG. 7 shows screen display 360 after the manipulated pages of FIG. 6 have been "registered," or "merged," into a single integrated image. *[emphasis added]* See column 8, line 35 to column 9, line 10.

The Examiner stated that Masuzaki et al. and Cullen et al. are combinable because both are in the art of combining images. The rationale is that it would have been obvious to have displayed images prior to the combination. See Office Action at page 4.

In Masuzaki et al. a text-editing apparatus is disclosed as having an editor for editing the original image data 11 on the display screen 15. In this apparatus, data edited on the display screen 15 is divided into the original image data 11 and the editing data 12. Thereafter, the data 11 and 12 are individually stored in a temporary storage area. In other words, the editing data 12 is made after the original image data 11 is edited on the display screen 15. Therefore, this apparatus cannot display the editing data 12 prior to editing the original image data 11 in contrast to the assertion by the Examiner. *[emphasis added]*

Further, the Examiner stated that the motivation for combining Masuzaki et al. and Cullen et al. would have been to allow users to preview how an image will look when combined. However, the apparatus of Masuzaki et al. allows users to edit the original image data 11 only on the display screen 15 and allows the original image data 11 and the editing data 12 to be combined only in order to confirm what part of an image displayed on the display screen 15 are modified. *[emphasis added]* In other words, there is no motivation in Masuzaki et al. to display the original image data 11 and the editing data 12 prior to combining them. Consequently, Applicant respectfully traverses the Examiner's motivation to combine these two references. See *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) ("Combining the teachings of references does not involve an ability to

combine their specific structures."). Furthermore, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.).

Even assuming *arguendo* that the Cullen et al. reference teaches "displaying...prior to combining" it is completely silent about "displaying collectively as a group" or "outputs collectively as a group" as recited in amended claims 1 and 8. Instead, Cullen et al. merely processes oversize images so that when an oversize image is scanned in multiple parts to produce multiple image fragments, the user can manipulate the image fragments by performing drag, drop and merge operations on the image fragments. *See Abstract*.

In contrast, in the present invention, the two original monochromatic image data for output are displayed or output collectively as a group, (such as "input data file 1" and "input data file 2") prior to being combined together, so as to create the original multicolor image data for output. The two original monochromatic image data for output "input data file 1" and "input data file 2" are independent of each other, are rasterized in page units, and are displayed in a row on the screen.

Thus, the combination of references does not render the presently claimed invention obvious.

Moreover, as claims 4 -8, 11 – 14, 16, and 18 -20 depend from one of independent claim 1 or 8, these claims are believed to be allowable for at least similar reasons.

Claim 15 recites *inter alia*, "displaying the plurality of rasterized image data at a display apparatus collectively as a group; and forming an original multicolor image file for output,...by

combining a plurality of groups, where were displayed prior to combining said plurality of groups at the display apparatus.

Regarding claim 15, Speciner et al. teaches a computer system and process for efficient processing of a page description using a display list. The Examiner asserts that both the spooling and rasterizing of images are conventional in the art as taught by Speciner et al.

The arguments above with respect to Masuzaki et al. and Cullen et al. are incorporated by reference. Even assuming *arguendo* that the Examiner is correct regarding Speciner et al., the reference fails to cure the deficiencies of Masuzaki et al. and Cullen et al. regarding the feature “displaying...collectively as a group.” Speciner et al. is completely silent with respect to this feature.

Thus, none of the cited references individually or in combination render the presently claimed invention obvious.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a).

ALLOWABLE CLAIMS

Claims 17 and 21 – 24 continue to be allowed. Applicant thanks the Examiner for the indication of allowable subject matter.

CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant

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respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,
NATH & ASSOCIATES PLLC

Date: August 14, 2007
THE NATH LAW GROUP PLLC
112 South West Street
Alexandria, VA 22314
Tel. (703) 548-6284
Fax. (703) 683-8396

By: 

Gary M. Nath
Registration No. 26,965
Jerald L. Meyer
Registration No. 41,194
Teresa M. Arroyo
Registration No. 50,015
Customer No. 20529